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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/638,587	08/15/2000	Joseph F. Scalisi	30639.2600	5402

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EXAMINER

BANGACHON, WILLIAM L

ART UNIT

PAPER NUMBER

2635

DATE MAILED: 07/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/638,587

Applicant(s)

SCALISI ET AL.

Examiner

William Bangachon

Art Unit

2635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 and 11-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Interview Summary.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-4, drawn to a method for generating two-way text messaging between a caller and a subscriber of a call receiving pager apparatus, classified in class 340, subclass 7.21.
 - II. Claims 5-10, drawn to a call receiving pager apparatus operative in a radiotelephone communications system, classified in class 455, subclass 408.
 - III. Claims 11-17, drawn to a call receiving paging apparatus comprising a housing including a printed circuit board contained therein and a detachable module, classified in class 340, subclass 7.63.
2. The inventions as claimed are distinct, each from the other because of the following reasons:

The claimed inventions I, II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a computer for sending email messages. Invention II has separate utility such as a telephone for making telephone calls. Invention III has separate utility such as a housing for a car/portable radio. See MPEP § 806.05(d).

3. Because these inventions (I and III vs. II) are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. Claude Nassis on July 1, 2003, a provisional election was made without traverse to prosecute the invention of Group II, claims 5-10. Applicant in replying to this Office action must make affirmation of this election. Claims 1-4 and 11-17 are withdrawn from further consideration by the examiner (37 CFR 1.142(b)) as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Oath/Declaration

6. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application-by-application number and filing date is required. See MPEP §§ 602.01 and 602.02.

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The oath or declaration is defective because:

It does not state that the person making the oath or declaration in a continuation-in-part application filed under the conditions specified in 35 U.S.C. 120 which discloses and claims subject matter in addition to that disclosed in the prior co pending application, acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56 which occurred between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application. Applicant has not made reference to the CIP by serial number in the declaration.

Specification

7. Applicant is requested to update the status of the parent applications listed under Cross-Reference to Related Applications (page 1).

8. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc. In this case, **the abstract recites the phrase "The present invention"** on page 41, line 5.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

10. Claims 6-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6-10 recite "The apparatus of claim 5 ...". It is unclear which apparatus the claims are referring to. There are at least 3 apparatuses (call receiving pager apparatus, telephone apparatus, and pager apparatus) mentioned in claim 5.

Claim 5 recites the limitation "said pager apparatus" in page 38, line 9, and "the pager apparatus" in page 39, line 13. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 5-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 5,117,449 (Metroka et al).

In claim 5, Metroka et al teach of a call receiving pager apparatus (figures 1 and 2) operative in a radiotelephone communications system {see whole document} comprising:

receiving means (105, 110) for receiving cellular signals {col. 1, lines 41-45; col. 3, lines 9-16};

transmitting means (109) for

a) transmitting cellular signals upon receipt of cellular signals by said receiving means to create a direct real-time two-way wireless communication between said call receiving pager apparatus and another telephone apparatus and {col. 1, lines 41-45; col. 4, lines 31-41, lines 54-55; col. 5, lines 45-59; col. 6, lines 31-40};

b) transmitting at least one of a voice message, a text message, or data message to a telephone number preprogrammed into said call receiving pager apparatus wherein said message asks a call receiver at said preprogrammed telephone number to initiate a call to said pager apparatus {col. 1, lines 26-30; col. 2, lines 19-23; col. 6, lines 11-65};

processing means (106) coupled to the receiving means (105, 110) and the transmitting means (109) for

a) processing said received cellular signals and only transmitting cellular signals in response to receipt of a signal having a correct mobile identification number of the pager apparatus {col. 1, lines 54-59; col. 6, lines 30-65},

b) producing an alert signal in response to receipt of a signal having the correct mobile identification number of the pager apparatus {col. 2, lines 31-36; col. 3, lines 40-42}, and

c) producing at least one of a voice message and a text message {col. 6, lines 31-40}; and

means for indicating reception of cellular signals coupled to the processing means {col. 1, lines 31-36; col. 2, lines 31-36; col. 3, lines 40-42, lines 60-65}.

Alternatively, Metroka et al teach of storing a paging message containing a telephone number {col. 6, lines 11-13} and/or storing cellular radiotelephone numbers for later use {col. 6, lines 32-40} but does not disclose expressly **“a message asking a call receiver at said preprogrammed telephone number to initiate a call to said pager apparatus”**. Obviously, whenever a caller dials another radiotelephone, the caller needs to speak to the called party. And if the caller does not reach the called party, the caller would leave a message instructing the called party to return back the callers call. And obviously, whenever a called party misses a call, the very next thing the called party does is to return the call, especially if it is an important call or a call originating from a loved one. The system of Metroka et al is capable of storing paging messages containing a telephone numbers {col. 6, lines 11-13} and/or storing cellular radiotelephone numbers {col. 6, lines 32-40}. Obviously, one of the stored paging messages would have a message that would state “Please call” or “Call me”, suggested as conventional by Metroka {col. 1, lines 24-30}. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to transmit a **“a message asking a call receiver at said preprogrammed telephone number to initiate a call to said pager apparatus”** in the system of Metroka, because whenever a caller dials another radiotelephone, the caller needs to speak to the called party. And if the caller does not reach the called party, the caller would leave a message instructing the called party to return back the call,

In claim 6, the apparatus of Claim 5 further comprising an ability for a user of the call receiving pager apparatus to receive text messages and send text messages to outside callers who previously called the apparatus {col. 3, lines 1-8; col. 6, lines 18-30}.

In claim 7, the apparatus of Claim 6 further comprising storage means for storing a caller's text message and a caller telephone number relating to the caller in the event that the user of the apparatus fails to respond to text message sent by the caller {col. 6, lines 18-40}.

In claim 8, the apparatus of Claim 7 further comprising search means for searching stored telephone numbers of callers who have previously called the apparatus {col. 6, lines 18-40}.

In claim 9, the apparatus of Claim 6 further comprising means for forming a text message with the apparatus which includes at least one of an alpha keypad (102) on the apparatus, a machine user interface (103) on the apparatus, and a separate device connected to the apparatus by a serial data input socket which can program information into the apparatus {col. 3, lines 33-40; col. 6, lines 41-65}.

In claim 10, the apparatus of Claim 5 further comprising means for allowing the caller to select at least one of a prerecorded voice or text {col. 6, lines 9-40}.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 5,842,141 (Vaihoja et al) is cited in that of a combined cellular telephone and pager with a switch to select between using the cellular telephone mode and pager mode {see whole document}.

US 3,755,794 (Stapleford) is cited in that it teaches of a message generator for generating canned messages.

Examiner Contact Information

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bangachon whose telephone number is 703-305-2701. The examiner can normally be reached on 4/4/10.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703-305-4704. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9314 for regular and After Final formal communications. The examiner's fax number is 703-746-6071 for informal communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

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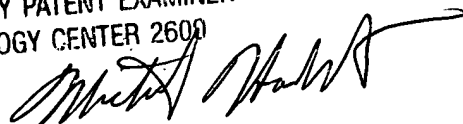
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William L Bangachon
Examiner
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July 10, 2003

MICHAEL HORABIK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to read "Michael Horabik", written over the printed name and title.